

REMARKS

In the Office Action mailed September 23, 2008, the Examiner rejected all pending claims 1-3, 5 and 7-15 under 35 U.S.C. § 102(e) as being anticipated by Casaccia (U.S. Patent No. 7,158,625).

I. Examiner Interview

Applicant thanks Examiner Tuankhanh Phan and Supervisor Don Wong for the telephone interview held on December 17, 2008 to discuss the rejections made in the Office Action mailed September 23, 2008 over the Casaccia reference. Particularly, Applicant reiterated previous arguments indicating why the Casaccia does not anticipate the present claims. Applicant stated that Casaccia does not teach “in response to the cancellation message, (i) completing setup of the conference leg between the conference server and the terminating station and (ii) then sending a teardown message from the conference server to the terminating station to tear down the conference leg between the conference server and the terminating station,” wherein “completing setup of the conference leg between the conference server and the terminating station comprises (i) the conference server receiving the agreement message from the terminating station and (ii) sending the acknowledgement message from the conference server to the terminating station,” as recited in claim 1, and similarly in claims 9 and 12.

Applicant explained that the method described in Figure 7 of Casaccia is conventional SIP signaling to establish a media session, and is also described in Applicant’s specification (*See Conventional Conference Session Setup, p. 9-10*). Figure 8 in Casaccia illustrates the automatic termination method; however, absent from the method in Figure 8 are steps to complete setup of a conference leg. The Examiner and Supervisor acknowledged that it is improper to combine the

conventional method of Figure 7 with the modified automatic termination method of Figure 8 to anticipate the present claims.

The Examiner and Supervisor requested that Applicant file a summary of the interview, including arguments made against the Casaccia reference, and that the present rejections over the Casaccia reference would be removed. Below is a summary of the arguments against the Casaccia reference. If there are any remaining questions regarding the Casaccia reference, the Office is invited to call the undersigned at (312) 913-3331.

II. Response to Rejection of Claims under 35 U.S.C. §102(e)

To anticipate a claim, each and every element as set forth in the claim must be found in a single reference (MPEP § 2131). But disclosure of each element is not quite enough—the Federal Circuit has long held that “anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim*.¹ *Finisar Corp. v. DirectTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir., April 2008) (emphasis added). Applicant submits that Casaccia does not teach all limitations of any of independent claims 1, 9 or 12 arranged as recited in the claims.

Casaccia teaches a method for automatically terminating a call between a first and second subscriber unit. Specifically, Casaccia teaches that a first user of the first subscriber station initiates a call to a second user of the second subscriber station and the first user then “hangs up” when the first user hears a ring tone indicating that the second subscriber station is ringing so as to “ring” the second user. (Col. 6, lines 3-30).

To implement the ringing method of its invention as shown in Figure 8, Casaccia describes modifications to a flow diagram of a conventional SIP media session setup, which is

shown in Figure 7. For example, conventionally, Casaccia describes a first user sending an INVITE message to the server, which forwards the INVITE to a second user. Next, the second user sends a RINGING message to the server, which forwards the message to the first user. (Col. 13, lines 9-58). When the second user accepts the call, the second user sends an OK agreement message to the server, which forwards the OK message to the first user. Then, the first user sends an ACK acknowledgment message directly to the second user, and a media session is created. (Col. 13, line 60 to Col. 14, line 11). The description of a conventional SIP media session has been known and is described in Applicant's specification at p. 9-10.

For the Casaccia ringing/automatic termination method, Casaccia describes the same initial steps of a first user sending an INVITE message, and the second user responding with the RINGING message. However, the INVITE message also includes a flag that indicates that the first user is only ringing the second user. After ringing, a CANCEL termination message is then sent to the proxy server, which forwards the CANCEL message to the second subscriber station. The call attempt is then terminated at the second subscriber station, which stops ringing when the termination message from the proxy server is received. (Col. 14, line 12 to Col. 15, line 35).

After sending the CANCEL message (or after sending the INVITE message that includes a cancellation indication), the call attempt is terminated. Casaccia does not teach "**in response to the cancellation message, (i) completing setup of the conference leg between the conference server and the terminating station and (ii) then sending a teardown message from the conference server to the terminating station to tear down the conference leg between the conference server and the terminating station,**" and "**wherein if the conference server has already received an agreement message from the terminating station agreeing to participate in the session, then completing setup ... comprises sending an acknowledgement message from the conference**

server to the terminating station,” and “if the conference server has not yet received the agreement message from the terminating station agreeing to participate in the session, then **completing setup ... comprises** (i) the conference server receiving the agreement message from the terminating station and (ii) sending the acknowledgement message from the conference server to the terminating station,” as in claim 1 or similarly in claims 9 and 12.

Casaccia does not describe sending and receiving the agreement and acknowledgement messages in response to receiving a cancellation message, as recited in claims 1, 9 and 12.

In fact, setup of a media session is never completed using the ringing methods described in Casaccia. That is the point of the invention in Casaccia, to ring a user without having the user answer the call. (Col. 6, lines 3-12). Under the ringing method, no media session (as described in Figure 7 (step 738) and as described in Applicant’s Conventional Conference Session Setup (p. 9-10)) is performed. Thus, Casaccia does not teach completing setup of the conference and then tearing down the conference in response to receiving a cancel message, as in the present claims, particularly because setup of a session is not completed using the ringing methods of Casaccia.

Applicant notes that sending a SIP “RINGING” message as in Casaccia does not complete setup of a conference leg. Both Casaccia and Applicant’s disclosure describe that completion of a conference requires the agreement and acknowledgment messages to establish the media session (*See Figure 7 of Casaccia and Applicant’s disclosure, p. 9-10*). A media session is not completed until both network elements accept, whereas the RINGING message is sent upon the receipt of an INVITE message.

With regard to dependent claims 3 and 5, Applicant describes a specific example of the present application using SIP. In that instance, the claims include:

1. The server has received a SIP INVITE message from the originating station seeking to set up a conference with the terminating station (claim 3)
2. The server then receives a SIP CANCEL message from the originating station before setup of the leg between the server and the terminating station is complete (claim 3)
3. In response to the SIP CANCEL message, the conference leg between the conference server and the terminating station is completed by sending a SIP ACK message from the conference server to the terminating station (claim 1)
4. Then, a SIP BYE message is sent from the conference server to the terminating station to tear down the conference leg between the conference server and the terminating station. (claim 3)

Applying Casaccia to Applicant's example using SIP as recited in dependent claims 3 and 5 illustrates another example of how Casaccia fails to teach Applicant's invention. Casaccia teaches (1) receiving a SIP INVITE message at the server and forwarding the INVITE message to the second user, (2) receiving a RINGING message at the server and forwarding the RINGING message to the first user, and then (3) receiving a CANCEL message at the server and forwarding the CANCEL message to the second user. (Figure 8).

In stark contrast, dependent claims 3 and 5 recite (1) receiving an INVITE message at the server, then (2) receiving at the server a CANCEL message from the originating station before setup of the conference leg between the conference server and the terminating station is complete, (3) in response to the SIP CANCEL message, completing setup of the conference leg between the server and the terminating station by sending a SIP ACK message from the server to the terminating station, and then (4) sending a SIP BYE message from the server to the

terminating station to tear down the conference leg between the conference server and the terminating station.

Casaccia does not describe the set of steps in the same order as recited in dependent claims 3 and 5.

III. Conclusion

Applicant respectfully requests withdraw of the pending claim rejections and issuance of a Notice of Allowance on the pending claims. The Examiner is invited to call the undersigned at (312) 913-3331 with any questions or comments.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: December 23, 2008

By: /Joseph A. Herndon/
Joseph A. Herndon
Reg. No. 50,469